

Application No.: 10/039654

Case No.: 53750US002

Remarks**35 U.S.C. § 102 Claim Rejections**

Claims 1-7, 9, and 10 and 12-20 stand rejected under 35 U.S.C. 102(b) as being anticipated by Clark et al. (U.S. Patent No. 5,853,846).

"The Examiner maintains that the connections relied upon in the rejections are frangible because the meaning of the term "frangible" is --breakable--. Because the connections could be broken, the claim limitations are met. In order for the rejections to be overcome, applicant must recite structural limitations not disclosed by the prior art.

Although Applicants does not necessarily agree with the rationale set forth by the Examiner, in the interests of expediting the prosecution, the Applicant has amended each of claims 1 and 15 to recite the limitations of claim 8. Further claim 15 has been amended to recite discreet magnetic pavement elements. Support for these amendments is found throughout the specification such as by the original claims as filed, Figures 1-7, and p. 14, line 17 to p. 15, line 30.

35 U.S.C. § 103 Claim Rejections

Claims 8 and 11 are rejected under 35 U.S.C. 103 (a) are being unpatentable over Clark et al as applied with respect to the previously stated 35 U.S.C. § 102 claim rejections, and further in view of Ryan et al. (U.S. Patent No. 4,123,140). The Examiner alleges that Ryan et al. teaches cutting a paving element formed on a carrier web.

At column 8, lines 28-34 Ryan et al. states that, "The reflective sheeting, therefore, is conveniently manufactured in continuous form and can be supplied in rolls of any reasonable width and length. This reduces manufacturing costs and facilitates shipping and storage, since a user may *cut* shapes of a wide variety of sizes as may be desired from a stock roll."

The Applicant submits that although Ryan teaches cutting reflective sheeting, Ryan fails to disclose at least partially severed around the perimeter of the magnetic pavement elements. Accordingly, assuming there was a motivation to combine the references as suggested by the Examiner, the combination would not arrive at the invention set forth in claims 1-7 and 15-20.

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Further, since neither reference teaches, "A method for making a magnetic pavement marker comprising the steps of forming an array of discreet magnetic pavement elements in a predefined pattern on a conformable carrier web." Claims 12-14 are also not anticipated by the cited references.

The Applicant has responded to all the rejections set for the by the Examiner. A timely allowance is respectfully requested.

Respectfully submitted,

10-31-03
Date

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